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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/607,855

06/27/2003

Shanti A. Cavanaugh

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04/02/2008

MORRISON & FOERSTER LLP

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SUITE 400

MCLEAN, VA 22102

EXAMINER

VU, PHU

ART UNIT

PAPER NUMBER

2871

MAIL DATE

DELIVERY MODE

04/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,855

Applicant(s)

CAVANAUGH ET AL.

Examiner

PHU VU

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/27/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/8/04, 7/28/04, 2/26/07, 4/09/07.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-3, 5-13, 15-19 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4-5, 9 and 20-23 of U.S. Patent No. 7,009,680. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rotating mirror of the patent is considered a reflective coating. Since the second surface of the first substrate faces the first surface of the second substrate than the mirrors deposited on the first surface of the first substrate and second surface of the second substrate must be placed on an outer surface of each substrate. Claims 1 and 2 of the patent disclose a narrowband liquid crystal tunable filter. Claims 4-5 of the patent disclose tuning by application of

voltage to a common electrode. Claims 9 discloses presence of an aperture (patterned hole) at an input and output of the device and also discloses a reflected passband output. Claim 21 discloses narrowband tunable filters configured with slightly different center frequencies (partially overlapping tuning range). Limitations of claim 12 are met when considering $n=1$. Claim 22, teaches alignment of multiple pixels in a single direction of the substrate length or width. Regarding limitations of claims 16-19 these appear to merely denote arbitrary groupings of signal input and output that but do not appear to structurally limit the device beyond the claims from which they depend.

Claim 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,009,680 in view of Lewis US Patent No. 6271899. Regarding claim 4 Lewis discloses use of quarter wave reflectors to enhance contrast levels in the device. Therefore, it would have been obvious to one of ordinary skill in the art to employ quart wave reflectors to enhance contrast.

Claims 14, 20 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4-5, 9 and 20-23 of U.S. Patent No. 7,009, 680 in view of Noto US 2002/0154268. Regarding claims 14, 20 and 21, Noto discloses an NxN pixel LC tunable filter that employs a cross switch type mux to enable selection of any combination of channels to a multitude of detectors ([0092]-[0094]). Therefore, at the time of the invention it would have been obvious to employ a filter with pixels arranged by row and column along length and width of a substrate and

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employ MUXes with integrated photodetector taps to enable free selection of any combination of channels of the LC cavity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU VU whose telephone number is (571)272-1562.

The examiner can normally be reached on 8AM-5PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (571)-272-1787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phu Vu
Examiner
AU 2871

/David Nelms/
Supervisory Patent Examiner, Art Unit 2871

